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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,629	07/17/2003	Joseph T. O'Brien	65783-0029	1873

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EXAMINER

MACARTHUR, VICTOR L

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,629

Applicant(s)

O'BRIEN ET AL.

Examiner

Victor MacArthur

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 17-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29 is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7-12, 17-21 and 23-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Mizusawa (U.S. Patent 4,488,206).

Claim 1. Mizusawa discloses (figs.3) a plug (1) inserted into and enclosing an opening (6) within a wall (wall of 5) of a hollow post (5) and securing a wire harness (13) running within the hollow post, comprising: at least two locks (left side 14, right side 14) projecting out from a surface of the plug and securing the plug within the opening, at least one of the locks (right 14) being located at or near a first end (right end of 1) of the plug, and at least one of the locks (left 14) being located at or near a second end (left end of 1) of the plug within the opening along a first axis (axis connecting left 14 and right 14); at least two tensioners (top left 14; bottom left 14) projecting out from the surface of the plug and resiliently engaging the edge of the opening and aligning the plug within the opening along a second axis (axis connecting top left 14 and bottom left 14), at least one of the tensioners (top left 14) being located at or near a first edge (top edge of 1) of the plug, and at least one of the resilient tensioners (bottom left 14) being located at or near a second edge (bottom edge of 1) of the plug; at least one stabilizer (12) projecting out from the surface of the plug and resiliently engaging the wall, thereby exerting

tension within the plug along a third axis (axis between 1 and 5); and at least one fastener (2 and ends of 13) for securing the wire harness to the plug.

Claim 2. Mizusawa discloses that the first and second axes are approximately perpendicular to one another (side to side and top to bottom).

Claim 3. Mizusawa discloses that the third axis (running between 5 and 1 in and out) is perpendicular to said first and second axes.

Claim 4. Mizusawa discloses that the first and second ends of the plug lie opposite to one another, and the first and second edges of the plug lie opposite to one another.

Claim 5. Mizusawa discloses that the hollow post is a pillar of an automobile.

Claim 7. Mizusawa discloses that at least one stabilizer comprises a pair of resilient protrusions extending out from the surface of the plug.

Claim 8. Mizusawa discloses at least two stabilizers (top wall of 12, bottom wall of 12), with at least one of the stabilizers located near the first edge of the plug, and at least one of the stabilizers located near the second edge of the plug.

Claim 9. Mizusawa discloses that the fastener comprises at least one clip (clips at top of 13 as seen in fig.3) that projects out from the surface of the plug and secures the wire harness.

Claim 10. Mizusawa discloses that the fastener comprises a tie (tie portion of 13, as seen in fig.9, as wrapping around two left portions of 13 and attaches to 1) that wraps around the wire harness and then attaches to the plug.

Claim 11. Mizusawa discloses that each of the at least two locks initially engages the edge of the opening with a generally rounded end portion (generally rounded end portions of left side 14 and right side 14) that promotes alignment of the plug respective to the opening.

Claim 12. Mizusawa discloses that each of the at least two tensioners initially engages the edge of the opening with a generally rounded end portion (generally rounded end portions of top left 14 and bottom left 14) that promotes alignment of the plug respective to the opening.

Claim 17. Mizusawa discloses (fig.3) a pillar shield, comprising: a generally planar-shaped body (1); at least two clips (left side 14 and right side 14) projecting out from the body of the pillar shield each of the at least two clips having resilient locks (18 on left side 14; and 18 on right side 14); at least two tensioners (top left 14 and bottom left 14) projecting out from the body of the pillar shield, the at least two tensioners each having a portion (18 on top left 14; and 18 on bottom left 14); at least two stabilizers (top wall of 12 and bottom wall of 12) projecting out from the body of the pillar shield and at least one fastener (2 and ends of 13). Additionally, Mizusawa further discloses the claimed functional limitations since it is fully capable of such function as follows:

- The planar shaped body (1) is designed to close off an opening within a wall of a pillar (in that it is designed to have square solid structure fully capable of filling a square opening within a wall of a pillar).
- The resilient locks (18 on left side 14; and 18 on right side 14) are configured for securing the pillar shield within an opening in a wall (in that they are configured with a tapered shape capable of such securing via contact with an edge of an opening in a wall).
- The resilient locks (18 on left side 14; and 18 on right side 14) are configured for being compressed by an edge of an opening to align a pillar shield within an opening along a first axis (in that they are configured as being attached to a leaf spring 17

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which is attached to the pillar shield and fully capable of allowing and edge of an opening to compress the locks to align the pillar shield within the opening along a first axis).

- The stabilizers (top wall of 12 and bottom wall of 12) are arranged to be resiliently compressed by a wall of a pillar thereby directing a force along a third axis tending to push a shield away from a wall (in that they are arranged on one side of a shield 1 such that a wall of a pillar could compress the stabilizers from behind thereby directing a force along a third axis tending to push the shield away from a wall).

Finally, Mizusawa meets the following intended use limitation since it is fully capable of such usage as follows:

- The pillar shield is fully capable of being for securing a wire harness running within a pillar including a wall having an opening with an edge since it presents structure capable securing a wire harness (via, fasteners, tape, glue, etc.) within a pillar including a wall having an opening with an edge (i.e. an edge shaped complementary to the shield).
- The tensioners' portions (18 on top left 14; and 18 on bottom left 14) are fully capable of performing use as for being compressed by an edge of an opening to align a pillar shield within an opening along a first axis (in that they are configured as being attached to a leaf spring 17 which is attached to the pillar shield and fully capable of allowing and edge of an opening to compress the locks to align the pillar shield within the opening along a first axis).

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- The fastener is fully capable of being for attaching a wire harness (i.e., two wires connected to 13) to the pillar shield as shown in fig.3.

Claim 18. The applicant does not positively recite, but rather only functionally recites, a first and second axis such that the Mizusawa assembly is similarly capable of function along a first axis that lies approximately ninety degrees from a second axis.

Claim 19. The applicant does not positively recite, but rather only functionally recites, a first, second and third axis such that the Mizusawa assembly is similarly capable of function along a third axis that lies perpendicular to the first and second axis.

Claim 20. Mizusawa discloses that at least one of the clips is located at an end (left end of 1) of the pillar shield, and at least one of the clips is located at an opposite end (right end of 1) of the pillar shield.

Claim 21. Mizusawa discloses that at least one of the tensioners is located nearby an edge (top edge of 1) of the pillar shield, and at least one of the tensioners is located nearby an opposite edge (bottom edge of 1) of the pillar shield.

Claim 23. Mizusawa discloses that the fastener comprises at least one clip (portion of 13, as seen in fig.9, clipping onto the two left portions of 13) projecting out from the body of the pillar shield and securing the wire harness.

Claim 24. Mizusawa discloses that the fastener comprises a tie (tie portion of 13, as seen in fig.9, as wrapping around two left portions of 13 and attaches to 1) that wraps around the wire harness and then attaches to the pillar shield.

Claim 25. Mizusawa discloses (fig.3) a pillar shield, comprising: a generally planar-shaped body (1); at least two clips (left side 14 and right side 14) projecting out from the body of the pillar shield each of the at least two clips having resilient locks (18 on left side 14; and 18 on right side 14); at least two stabilizers (top wall of 12 and bottom wall of 12) projecting out from the body of the pillar shield and at least one fastener (2 and ends of 13). Additionally, Mizusawa further discloses the claimed functional limitations since it is fully capable of such function as follows:

- The planar shaped body (1) is designed to close off an opening within a wall of a pillar (in that it is designed to have square solid structure fully capable of filling a square opening within a wall of a pillar).
- The resilient locks (18 on left side 14; and 18 on right side 14) are configured for securing the pillar shield within an opening in a wall (in that they are configured with a tapered shape capable of such securing via contact with an edge of an opening in a wall).
- The resilient locks (18 on left side 14; and 18 on right side 14) are configured for being compressed by an edge of an opening to align a pillar shield within an opening along a first axis (in that they are configured as being attached to a leaf spring 17 which is attached to the pillar shield and fully capable of allowing an edge of an opening to compress the locks to align the pillar shield within the opening along a first axis).
- The stabilizers (top wall of 12 and bottom wall of 12) are arranged to be resiliently compressed by a wall of a pillar thereby directing a force along a third axis tending to

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push a shield away from a wall (in that they are arranged on one side of a shield 1 such that a wall of a pillar could compress the stabilizers from behind thereby directing a force along a third axis tending to push the shield away from a wall).

Finally, Mizusawa meets the following intended use limitation since it is fully capable of such usage as follows:

- The pillar shield is fully capable of being for securing a wire harness running within a pillar including a wall having an opening with an edge since it presents structure capable securing a wire harness (via, fasteners, tape, glue, etc.) within a pillar including a wall having an opening with an edge (i.e. an edge shaped complementary to the shield).
- The fastener is fully capable of being for attaching a wire harness (i.e., two wires connected to 13) to the pillar shield as shown in fig.3.

Claim 26. The applicant does not positively recite, but rather only functionally recites, a first and second axis such that the Mizusawa assembly is similarly capable of function along a first axis that lies approximately ninety degrees from a second axis.

Claim 27. Mizusawa discloses (fig.3) a pillar shield, comprising: a generally planar-shaped body (1); at least two clips (left side 14 and right side 14) projecting out from the body of the pillar shield each of the at least two clips having resilient locks (18 on left side 14; and 18 on right side 14); at least two tensioners (top left 14 and bottom left 14) projecting out from the body of the pillar shield, the at least two tensioners each having a portion (18 on top left 14; and 18 on bottom left 14); and at least one fastener (2 and ends of 13). Additionally, Mizusawa

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further discloses the claimed functional limitations since it is fully capable of such function as follows:

- The planar shaped body (1) is designed to close off an opening within a wall of a pillar (in that it is designed to have square solid structure fully capable of filling a square opening within a wall of a pillar).
- The resilient locks (18 on left side 14; and 18 on right side 14) are configured for securing the pillar shield within an opening in a wall (in that they are configured with a tapered shape capable of such securing via contact with an edge of an opening in a wall).
- The resilient locks (18 on left side 14; and 18 on right side 14) are configured for being compressed by an edge of an opening to align a pillar shield within an opening along a first axis (in that they are configured as being attached to a leaf spring 17 which is attached to the pillar shield and fully capable of allowing an edge of an opening to compress the locks to align the pillar shield within the opening along a first axis).

Finally, Mizusawa meets the following intended use limitation since it is fully capable of such usage as follows:

- The pillar shield is fully capable of being for securing a wire harness running within a pillar including a wall having an opening with an edge since it presents structure capable securing a wire harness (via, fasteners, tape, glue, etc.) within a pillar including a wall having an opening with an edge (i.e. an edge shaped complementary to the shield).

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- The tensioners' portions (18 on top left 14; and 18 on bottom left 14) are fully capable of performing use as for being compressed by an edge of an opening to align a pillar shield within an opening along a first axis (in that they are configured as being attached to a leaf spring 17 which is attached to the pillar shield and fully capable of allowing an edge of an opening to compress the locks to align the pillar shield within the opening along a first axis).
- The fastener is fully capable of being for attaching a wire harness (i.e., two wires connected to 13) to the pillar shield as shown in fig.3.

Claim 28. The applicant does not positively recite, but rather only functionally recites, a first and second axis such that the Mizusawa assembly is similarly capable of function along a first axis that lies approximately ninety degrees from a second axis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizusawa (U.S. Patent 4,488,206) in view of the Applicant's admitted prior art (Figures 1 and 2).

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Claims 6 and 22. Mizusawa does not disclose that the plug/pillar shield is a one-piece monolithic structure. The Applicant's admitted prior art (figs. 1 and 2) illustrates that one-piece monolithic structure plugs/pillar shields (200) are old and well known in the art. One of ordinary skill in the art would easily recognize that one-piece monolithic construction reduces the number of parts to be assembled and thus inherently simplifies assembly. It has generally been recognized that one-piece construction, in place of separate elements fastened together, is a design consideration within the skill of the art. In re Kohn, 391 F.2d 959, 157 USPQ 275 (CCPA 1968); In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965). Accordingly, it would have been obvious to one of ordinary skill in the art to modify Mizusawa plug/pillar shield to be of one-piece monolithic structure, to simplify assembly, since such practice is old and well known in the art and since it is a design consideration within the skill of the art.

Allowable Subject Matter

Claim 29 is allowed for reasons stated in the "Allowable Subject Matter" section of the previous office action.

Response to Arguments

Applicant's arguments with regard to the claim rejections have been fully considered but they are not persuasive.

The applicant argues that the Mizusawa stabilizer (12) does not exert or generate tension along a third axis since the Mizusawa stabilizer only generates "moderate pressure" as recited in Mizusawa, col.6, ll.1-3). This is not persuasive. The claims do not recite any specific degree of

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tension. Such that moderate tension in parts caused by moderate pressure read on the applicant's claims just as much as a great pressure and tension would.

The applicant argues that Muzusawa body is not "generally planar shaped" since it comprises non-planar aspects. This is not persuasive since the limitation the claims have a scope that does not require a perfectly planar shape but rather a "generally planar" shape that may or may not have various non-planar attributes in addition to its planar attributes. The Muzusawa body presents many planar surfaces such that it is "generally planar shaped" within the broadest reasonable interpretation of the claim language. Note that the applicant's own invention is not perfectly planar but rather has numerous non-planar projections.

The applicant argues that there is no motivation to combine Muzusawa and the applicant's admitted prior art. This is not persuasive. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the **knowledge generally available to one of ordinary skill in the art** (emphasis added). See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation comes from knowledge generally available to one of ordinary skill in the art (i.e. knowledge that one-piece monolithic construction reduces the number of parts to be assembled and thus inherently simplifies assembly over multi piece construction).

The applicant argues that Mizusawa is not bodily incorporable with the applicant's admitted prior art. This is not persuasive. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor

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is it that the claimed invention must be expressly suggested in any one or all of the references.

Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

However, though not necessary for a proper obviousness rejection, the examiner notes that making elements 14 unitarily homogenous with, rather than removable from, element 1, would not detract from the installation purpose of the assembly into element 5, since elements 14 are attached to element 1 prior to insertion into element 5 anyway. In fact homogenous construction can only simplify assembly by omitting the need for the step of attaching 14 to 1. If the applicant means to imply that one of ordinary skill in the art could not conceive of combining Mizusawa with the admitted prior art without destroying the light supporting function of Mizusawa (i.e. making the light bulb, wires, and car all one piece such that they have not moving parts and cannot function as commonly known) then the examiner reminds the applicant that in an obviousness assessment, skill is presumed on the part of the artisan, rather than the lack thereof. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). Accordingly, it is inconceivable that a person of ordinary skill in the art would have failed to appreciate that elements 14 could be made homogenous with element 1 without the destroying the function of the car and lights of Mizusawa. Such an argument by the applicant would require an improper assumption that the artisan possesses less than ordinary skill.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

VLM

VLM

September 4, 2005

Daniel P Stodola

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